

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte REX A. BERKEY ET AL.

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Appeal No. 1999-0285  
Application No. 08/697,573<sup>1</sup>

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ON BRIEF

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Before FRANKFORT, NASE, and GONZALES, Administrative Patent Judges.

NASE, Administrative Patent Judge.

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<sup>1</sup> Application for patent filed August 27, 1996. According to the appellants, the application is a division of Application No. 08/207,961, filed March 7, 1994, now U.S. Patent No. 5,595,470.

Appeal No. 1999-0285  
Application No. 08/697,573

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 25 to 30, 32, 33 and 41 to 47, as amended subsequent to the final rejection. These claims constitute all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method of lifting a person or passenger. An understanding of the invention can be derived from a reading of exemplary claim 25, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

O'Brien et al. (O'Brien)	3,888,463	June
10, 1975		
Houle	4,971,510	Nov. 20,
1990		

Claims 41 to 47 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 25 to 28, 30, 32 and 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over O'Brien.

Claim 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over O'Brien in view of Houle.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 18, mailed July 22, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 15, filed February 2, 1998) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The indefiniteness rejection**

We will not sustain the rejection of claims 41 to 47 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as

precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

With this as background, we turn to the rejection under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal. Specifically, the examiner stated (answer, p. 3) that in claim 41

it is not understood whether the predetermined safety switch height is the same in line 16, in line 19 [,] in line 22 and in line 25; also, in line 18, it is not clear where the stabilizing arm is structurally located re the lift arm.

The appellants argue (brief, pp. 4-6) that those skilled in the art "can easily understand the scope of Claim 41 in light of Applicants' specification" and accordingly claim 41 "satisfies the requirements of Section 112, second paragraph." Specifically, the appellants assert that those skilled in the art would understand that claim 41 is reciting either the lift arm limit switch or the stabilizing arm limit switch. The

appellants further assert that the structural location of the stabilizing arm with respect to the lift arm is not an essential limitation.

In response to this argument of the appellants, the examiner stated (answer, p. 4) that the argument "is not well-taken since the claimed subject matter, not the specification is the measure of the invention."

We agree with the appellants that the scope of claim 41 would be understood by those skilled in that art. In that regard, we note that (1) the examiner has not provided any explanation as to why the failure of claim 41 to structurally locate the stabilizing arm relative to the lift arm is necessary to understand the scope of claim 41;<sup>2</sup> and (2) those skilled in the art would understand that claim 41 is reciting "monitoring the raising the basket step" with either a lift arm limit switch or a stabilizing arm limit switch, and

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<sup>2</sup> We note that breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689,, 169 USPQ 597 (CCPA 1971).

"shutting down the lifter" when the provided limit switch (i.e., the lift arm limit switch or the stabilizing arm limit switch) detects its respective arm (i.e., the lift arm or the stabilizing arm).

For the reasons stated above, the decision of the examiner to reject claims 41 to 47 under 35 U.S.C. § 112, second paragraph, is reversed.

#### **The obviousness rejections**

We will not sustain the rejection of claims 25 to 30, 32 and 33 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d



1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we turn to the examiner's rejection of claim 25 (the only independent claim rejected

under 35 U.S.C. § 103). The examiner determined (answer, p. 3) that

O'Brien et al disclose a manually operable lift used with aircraft (column 1, line 24) and having plural wheels 26, adjustable limit switches (and column 2, lines 67, 68 etc.) chassis 20, basket 94, etc., paired lift arms 81 with stabilizing arms 83, energy source 138, energy converter 136, 122, etc., rear support 24, etc., bearing assemblies 109, etc., lifting means 85 and common means 141-143.

The examiner then concluded that "[i]t would have been obvious to have conventionally shifted the switch to allow the platform to attain a preset limit, if desired." Thereafter, the examiner determined that the subject matter recited in dependent claims 26, 28, 29 and 30 would have been obvious from the applied prior art.

The appellants argue (brief, p. 7) that the step of "moving the lift with the person in the basket into a position aligned with the structure's opening" as set forth in claim 25 is not taught, suggested or made obvious from O'Brien.

In response to this argument of the appellants, the examiner stated (answer, pp. 4-5) that the argument is

not well-taken since the basket (with the person therein) of O'Brien et al. could not clear the fuselage of the airplane without movement during lifting and alternately, the basket (with the person therein) could not be lowered without moving the basket away [from] the fuselage.

We agree with the appellants' argument that the step of "moving the lift with the person in the basket into a position aligned with the structure's opening" as set forth in claim 25 is not taught, suggested or made obvious from O'Brien.<sup>3</sup> In that regard, the examiner's position that the lift of O'Brien would be moved with a person in the basket (i.e., platform 94) is based on speculation unsupported by the disclosure of O'Brien.

Since all the limitations of claim 25, and claims 26 to 30, 32 and 33 dependent thereon, are not met from O'Brien as

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<sup>3</sup> We reach no opinion on whether this limitation would have been obvious to one of ordinary skill in the art at the time the invention was made from the teachings of Houle (see especially, column 3, lines 43-48). While Houle was applied by the examiner in the rejection of claim 29, it was not applied by the examiner as suggesting this limitation of claim 25.

modified by the examiner in the rejections set forth on pages 3-4 of the answer, the decision of the examiner to reject claims 25 to 30, 32 and 33 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 41 to 47 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 25 to 30, 32 and 33 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

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APPEAL NO. 1999-0285 - JUDGE NASE  
APPLICATION NO. 08/697,573

APJ NASE

APJ GONZALES

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 11 Jun 99

**FINAL TYPED:**